

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Kevin Austin O'Dea et al.

Group Art Unit: 3683

Serial No.: 10/761,257

Examiner: Schwartz, Christopher P.

Filing Date: January 21, 2004

For: MODULATOR NOISE REDUCTION
VIA MOTOR CONTROL

Docket No.: DP-309754

REQUEST FOR RECONSIDERATION

Entry

Approved

cps

2/11/08

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

Dear Sir:

Applicant hereby requests reconsideration of the Final Office Action mailed on November 16, 2007. In particular, the dependent claims are not fully or adequately addressed by the Official Action such that the Applicant cannot determine how best to proceed. Due to the incomplete and unclear nature of the Official Action, Applicant respectfully requests that the current Official Action be withdrawn. If a subsequent Official Action, which would presumably address all of the pending claims, is mailed, then this subsequent Official Action should be non-final and the time period for responding should be restarted.

In the current Official Action, all of the claims are generically rejected under 35 U.S.C. 103(a) as being unpatentable over Pueschel et al. '126 in view of Katinas and Busch et al. '033.

The Examiner specifically states “[r]egarding claim 1 Pueschel . . .”. Hence, the Examiner has put forth a good faith effort to address the limitations of claim 1. The dependent claims, however, are NOT adequately addressed and there is great confusion regarding the rejections of these claims.

Specifically, regarding claims 2-5, the Examiner states:

[d]ue to the striking similarity between applicants system and that of Pueschel et al. and Itoh et al [*sic*] limitations of claims 2-5 are considered to be an obvious variation to Pueschel et al. as modified, since the valving arrangements of Pueschel et al. and Itoh et al. are obviously interchangeable.

As should be evident, the primary flaw in this contention is that the claims are not being rejected in view of “Itoh et al.”. This error was highlighted to the Examiner in Applicant’s previous response filed on September 6, 2007 (see the second to last paragraph on page 6). The Examiner has chosen to ignore Applicant’s pleas for clarity and has therefore created confusion with regards to the rejections of claims 2-5.

Regarding claims 6-9, these claims are not addressed by the Examiner in the current Official Action. In fact, although the Examiner has had numerous opportunities to do so, these claims have never been specifically addressed by the Examiner since their introduction on March 3, 2005. As perhaps best set forth in various sections of the Appeal Brief filed on November 5, 2005, claims 6-9 set forth various additional unique and non-obvious features of the invention. Again, due to the Examiner’s failure to address claims 6-9, there is substantial confusion on how the Examiner can sustain a rejection of these claims based on the prior art of record.

In accordance with 37 CFR 1.104, an Official Action is to be complete as to all matters. The Examiner has failed to completely and accurately explain the rejections of the dependent claims such that the current rejections create substantial confusion and the Official Action should be withdrawn.

In addition to the above, the Applicant contends that any subsequent Official Action should be non-final. In accordance with MPEP §706.07, a clear issue should be developed between the Examiner and applicant before final rejection is in order. Applicant respectfully contends that due to errors by the Patent Office, the patentability issues for claim 2-9 are unclear. As stated in §706.07, "Switching ... from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue ..." Also, "present practice does not sanction hasty and ill-considered final rejections. ... applicant who is seeking to define his or her invention ... should receive the cooperation of the examiner ... and not be prematurely cut off in the prosecution of his or her application."

As stated above, the rejections of claims 2-9 are incomplete and unclear. Applicant has therefore not had an opportunity to amend or traverse the rejections of these claims thereby clearly defining the issues of patentability in which the Applicant and Examiner do not agree. As such, the current Official Action should be withdrawn and any subsequent Official Action rejecting the claims should be non-final.

It is respectfully submitted that the subject application is in condition for allowance. Although no fees are believed due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 08-2789 in the name of Howard & Howard Attorneys, P.C.

Respectfully submitted,

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